

REMARKS

Claims 10 and 12 are original. Claims 1-9, 11, and 13-26 are withdrawn.

Election/Restriction Requirement

5 The claims are subjected to a restriction requirement under 35 U.S.C. §121
as containing ten patentably distinct inventions:

10 I. Claims 1-8, drawn to an on-line print network comprising a
plurality of computer entities connected by a communications network,
for providing on-line print services, classified in class 705, subclass 26.

 II. Claim 9, drawn to a print service provider operation, classified in
class 705, subclass 26.

15 III. Claim 10-13, drawn to a method of providing on-line print
services, classified in class 709, subclass 220.

20 IV. Claim 14-20, drawn to a method of allocating a plurality of print
items amongst a plurality of printer devices, classified in class 358,
subclass 1.15.

25 V. Claim 21, drawn to an on-line print network comprising a
plurality of computer entities connected by a communications network,
for providing on-line print services, classified in class 709, subclass
220.

30 VI. Claim 22, drawn to an on-line print network comprising a
plurality of computer entities connected by a communications network,
for providing on-line print services, classified in class 705, subclass 26.

 VII. Claim 23, drawn to a method of providing on-line print services,
classified in class 705, subclass 26.

35 VIII. Claim 24, drawn to a method of providing on-line print services,
classified in class 705, subclass 34.

IX. Claim 25, drawn to a method of allocating a plurality of print items amongst a plurality of printer devices, classified in class 358, subclass 1.15.

5 X. Claim 26, drawn to a print service provider operation, classified in class 705, subclass 26.

Group A (including inventions I, V, VI), pertaining to a network.

10 Group B (including inventions II, X), pertaining to an operation.

Group C (including inventions III, IV, VII, VIII, IX), pertaining to methods.

15 Applicant hereby elects, **with traverse**, to prosecute Group III, species b, claims 10 and 12 in the event that the restriction requirement is maintained.

Applicant argues below that the Office's restriction requirement is improper under MPEP 803 because examining the Application on its merits does not place the Office under a serious burden. Applicant also argues that the current
20 restriction requirement is unduly burdensome on the Applicant and will increase the burden on the Office.

No Serious Burden Under MPEP 803

The Office **must** examine an entire application on the merits even if the
25 application includes claims to distinct or independent inventions if the search and examination of an entire application can be made without serious burden on the Office. MPEP 803 states:

30 If the search and examination of an entire application can be made without serious burden, the examiner ***must*** examine it on the merits, ***even though it includes claims to distinct or independent inventions***. (Emphasis added).

This requirement logically also applies to sets of claims within an application. Thus, if a particular set of claims in an application may be searched and examined without serious burden on the Office, the Office should examine
5 that set of claims on the merits without requiring an election to a subset of those claims. *See* MPEP 803.

Applicant submits that each of the following four sets of claims may be conveniently searched and examined together without a serious burden to the Office. Each of these sets of claims have been classified and sub-classified
10 identically by the Office. By so classifying these sets of claims, the Office has implicitly established that each set may be searched and examined without a serious burden on the Office.

The four sets of claims A, B, C, and D are set forth below, along with the class and subclass given by the Office for each:

15 A. Claims 1-9, 22, 23, and 26, all of which have been classified in class 705, subclass 26.

20 B. Claims 10-13 and 21, all of which have been classified in class 709, subclass 220.

C. Claims 14-20 and 25, all of which have been classified in class 358, subclass 1.15.

25 D. Claim 24, classified in class 705, subclass 34.

For at least this reason, the Office should permit Applicant to select any one of these four sets of claims for examination on the merits. Applicant provisionally elects set B, claims 10-13 and 21 should the Office permit.

Unduly Burdensome on Applicant

The Office requires that Applicant elect only one of the following sets of claims:

- 5 1. Claims 1 and 2 (Invention I, species a).
2. Claims 1 and 3 (Invention I, species b).
3. Claims 1 and 4 (Invention I, species c).
4. Claims 1 and 5 (Invention I, species d).
5. Claims 1 and 6 (Invention I, species e).
- 10 6. Claims 1 and 7 (Invention I, species f).
7. Claims 1 and 8 (Invention I, species g).
8. Claim 9 (Invention II).
9. Claims 10 and 11 (Invention III, species a).
10. Claims 10 and 12 (Invention III, species b).
- 15 11. Claims 10 and 13 (Invention III, species c).
12. Claims 14 and 15 (Invention IV, presumably a species, but not
mentioned in Restriction).
13. Claims 14 and 16 (Invention IV, species a).
14. Claims 14 and 17 (Invention IV, species b).
- 20 15. Claims 14 and 18 (Invention IV, stated in Restriction as species
b, presumably species c).

16. Claims 14 and 19 (Invention IV, stated in Restriction as species b, presumably species d).

17. Claims 14 and 20 (Invention IV, stated in Restriction as species b, presumably species e).

5 18. Claim 21 (Invention V).

19. Claim 22 (Invention VI).

20. Claim 23 (Invention VII).

21. Claim 24 (Invention VIII).

22. Claim 25 (Invention IX).

10 23. Claim 26 (Invention X).

The Office is requiring that the Applicant elect from one of 23 groups of claims. If the Applicant desires to have all of the claims of this application examined at once, the Applicant will have to file 22 divisional applications. The
15 cost of this, in PTO fees alone, will be approximately \$22,000. And, on top of these fees, the Applicant will have to pay attorney's fees, administrative costs, and bear many other burdens.

The Office may search and examine the claims of this application with a four-way restriction without undergoing a serious burden and yet is requiring 23.
20 The time, effort, and costs to the Applicant caused by this restriction are extraordinary, placing an unreasonably heavy burden on the Applicant.

Increased Burden On The Office

Not only does this restriction place an undue burden on the Applicant it also increases the burden on the Office.

Processing one (or the proposed four) applications instead of 23
5 applications will certainly require much less time for the Office to properly
examine, process, issue, and manage. Many of the burdens that the Office bears in
handling an application, especially administrative burdens, will be multiplied by
23. Withdrawing the restriction requirement and keeping the claims together in
one application or in four applications as proposed would prove more efficient and
10 effective for the Office in handling the subject invention.

Conclusion

Applicant respectfully submits that all of the pending claims are in condition for allowance. Accordingly, Applicant respectfully requests that the Office issue a Notice of Allowability. If the Office's next anticipated action is anything other than a Notice of Allowability, Applicant respectfully requests a phone call to discuss scheduling an interview.

Respectfully Submitted,

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